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EXAMINER

HUYNH, BA

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 28

Application Number: 09/040,539
Filing Date: 3/17/1998
Appellant(s): Akira Yoshida

Charles Berman
For Appellant

MAILED
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Technology Center 2100

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed on 11/05/01.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1-7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent 5,930,809 (Middlebrook) in view of US patent 6,054,990 (Tran). Claim 8 has been canceled.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is incorrect. The changes are as follows:

Whether claims 1-7, and 9 are unpatentable under 35 U.S.C. 103(a) over US patent 5,930,809 (Middlebrook) in view of US patent 6,054,990 (Tran). This is the only issue in this appeal. All other rejections have been withdrawn, namely:

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the 112-1st rejection of claims 1, 2,

the 102(e) rejection of claims 1, 4, and 6 based on US patent 5,945,998 (Eick),

The 103(a) rejection of claims 2, 3, 5, 7, and 9 based on the combination of US patents 5,945,998 (Eick) and 6,054,990 (Tran).

(7) *Grouping of Claims*

The brief includes a statement that claims 1-7, and 9 stand or fall together as a group.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

| | | |
|-----------|-------------|-----------|
| 5,930,809 | Middlebrook | 7/1999 |
| 6,054,990 | Tran | 4/25/2000 |

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-7 and 9 are rejected under 35 U.S.C. 103(a). This rejection is set forth in paragraph 11 of the prior Office action, Paper No. 17.

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(11) *Response to Argument*

Middlebrook teaches a window display device which displays document data which comprises text and image data on a display screen 30 (figure 2). A representation of a document is displayed in map box 34 (col. 3, lines 20-30). Map box 34 comprises a plurality of subscreen windows each enclosing a subscreen of image data representing separate paragraph or page (Textscape map 300 of figure 7. See col. 4, line 42 - col. 5, line 9). The first subscreen window of the Textscape map 300 represents a first page of the document (see the final rejection, paper 20, page 5, 3rd full par.). A main screen 32 displaying part of the first page with enlargement. A second subscreen window, adjacent to and below the first subscreen window, represents a second page of the document. An indicator 48 for indicating an area of image data in Textscape map 300 to be displayed in the main screen (col. 3, lines 58-65), the selected area having a boundary corresponding to the boundary of the enlarged image data in the main screen 32. The indicator 48 can be moved about within a subscreen windows or can be moved from subscreen window to the other corresponding to the movement of a pointing device (col. 4, lines 5-16). As the indicator 48 is moved within the first subscreen window of Textscape map 300, the displayed text in the main screen 32 changes in a corresponding manner (col. 4, lines 5-10) as notified by the first subscreen window. The indicator 48 can be moved within the first subscreen image window or to the second subscreen image window while the pointing device is in dragging state. Middlebrook fails to specifically teach that the indicator 48 having a frame, i.e., a boundary visualizing an area of selected image data to be displayed in the main window 32. In an analogous field of information

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scrolling and enlargement, Trans teaches the implementation of an indicating frame 106" for selecting an image data area to be displayed in the enlarged view (figure 2B). Thus it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine Tran's teaching of the indicating frame 106" to Middlebrook indicator 48. Motivation of the combining is for providing a visual indication of the selected image data area.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one of ordinary skill in the art would be motivated to combine Tran's indicating frame 106" to Middlebrook's indicator 48. Motivation of the combine is for providing a visual indication of the selected image data area. The indicating frame 106", as combined with Middlebrook, visually indicating the relationship between the displayed data in the main screen 32 and the selected portion of data in the Textscape map 300, allowing user control of the selection of image data by controlling the frame 106".

In response to the argument that Middlebrook's indicating icon 48 only can be moved within a single area of text, Middlebrook teaches that the map 36 may have the format of the Textscape map 300 (col. 4, line 34 - col. 5, line 15). Textscape map 300 has a plurality of

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subscreens, each representing a paragraph or a page (figure 7). The indicator icon 48 can be moved from page to page within the Textscape map 300 (col. 4, lines 5-16).

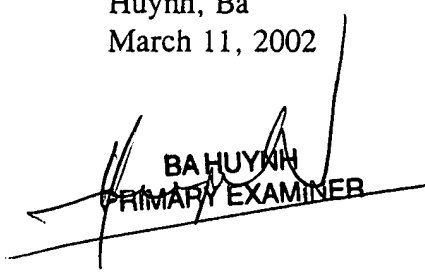
In response to the argument that Tran's selection frame 106" only can be moved within a single area, selection frame 106" is combined for its capability of selecting a frame of image data not for the moving from one subscreen to the others. The moving from one subscreen to the others is supported by Middlebrook when the selection frame 106" replacing the indicating icon 48. Once combined with Middlebrook, selection frame 106" can be moved from subscreen to subscreen of the Textscape map 300 as claimed. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). When the selection frame 106" is moved within the Textscape map 300 the main screen 32 is updated to reflect the image data located at the current position within the selection frame 106", thus provides a desirable visual relationship between the selected image data and the main screen.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Huynh, Ba
March 11, 2002


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